

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of Steven C. Black et al. )  
Serial No.: 10/848,809 )  
Filed: May 19, 2004 )  
Confirmation No.: 6228 ) Art Unit  
For: AUTOMATED COMPLIANCE FOR HUMAN ) 3629  
RESOURCE MANAGEMENT )  
Examiner: Shaun D. Sensenig )  
Appeal No.: \_\_\_\_\_ )

The Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

## BRIEF OF APPELLANTS

This is an appeal to the Board of Patent Appeals and Interferences (the "Board") from the Final Office Action mailed July 6, 2009 (the "Final Office Action") wherein the Examiner rejected claims 1-11, 15-18, 29-30, 32-35. This Brief is being filed pursuant to the provisions of 37 C.F.R. § 41.37. This Brief is accompanied by the requisite fee of \$270.00, as provided by 37 C.F.R. § 41.20(b)(2). The Commissioner is hereby authorized to charge any additional fees associated with this communication, or to credit any overpayment, to Deposit Account No. 23-3178.

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## **LIST OF REFERENCES**

### **U.S. PATENT DOCUMENTS**

- U.S. Patent No. 7,330,817 to *Exall et al.*
- U.S. Patent No. 6,067,522 to *Warady et al.*
- U.S. Patent Publication No. 2002/0055862 to *Jinks*

### **NON-PATENT LITERATURE**

- Peace Corps Applicant Toolkit ("PC")

## **I. REAL PARTY IN INTEREST**

The real party in interest comprises HOTLINKHR, INC., by way of assignment from Steven C. Black and John P. Boggs. The corresponding assignment document was recorded in the United States Patent and Trademark Office at Reel/Frame 015359/0937 on May 19, 2004. The named inventors, Steven C. Black and John P. Boggs, who are captioned in the present application, assigned their interest in the present application to HOTLINKHR, INC.

## **II. RELATED APPEALS AND INTERFERENCES**

None.

## **III. STATUS OF CLAIMS**

Claim 12-14 and 23-28 are withdrawn, claims 19-22, 31, and 35 are canceled, and claims 1-11, 15-18, 29, 30, and 32-34 are rejected. The indicated status of claims is as of the December 1, 2009 mailing date of the Examiner's acknowledgement of the paper canceling claim 35 (see IV. below). Claims 1-11, 15-18, 29-30, 32-34 are being appealed.

## **IV. STATUS OF AMENDMENTS**

The Appellants submitted an amendment canceling claim 35 in a paper filed October 6, 2009. An acknowledgement of the paper canceling claim 35 was mailed by the Examiner on December 1, 2009.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

It should be noted that nothing in the following discussion is intended, nor should be used, to construe the scope or meaning of any of the claims. Rather, the following discussion, and corresponding references to the specification and figures, are provided solely for informational purposes so as to comply with the formal requirements of 37 CFR § 41.37(c)(1)(v).

In the example of claim 1, a method (200) is claimed for a server (110) in a client-server environment (100) to facilitate the management of human resources compliance efforts. *See, e.g.,* pages 14-20, paragraphs [043]-[064]; *see also* Figures 1-2. The method (200) includes an act (220) of the server (110) generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria. *See, e.g.,* page 15, paragraphs [045]-[046]; *see also* Figure 2, act 220. The method (200) also includes an act (230) of the server (110) making the plurality of human resources compliance forms available to a client (120) and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client. *See, e.g.,* page 15-16, paragraphs [047]-[049]; *see also* Figure 2, act 230. The method (200) further includes an act (250) of the server (110) updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria. *See, e.g.,* page 17, paragraphs [051]-[052]; *see also* Figure 2, act 250. The method (200) also includes an act of the server (110) determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client. *See, e.g.,* page 17, paragraphs [051] and [053]. Finally, the method (200) also includes an act of the server (110) making the updated human resources compliance form available to the client. *See, e.g.,* page 15, paragraph [047].

In the example of claim 11, a computer program product is claimed which includes one or more computer-readable media having computer-executable instructions. *See, e.g.*, pages 9-10, paragraphs [024]-[026]. The computer-executable instructions implement a method (200) for a server (110) in a client-server environment (100) for facilitating the management of human resources compliance efforts. *See, e.g.*, pages 14-20, paragraphs [043]-[064]; *see also* Figures 1-2. The method (200) includes an act (220) of the server (110) generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria. *See, e.g.*, page 15, paragraphs [045]-[046]; *see also* Figure 2, act 220. The method (200) also includes an act (230) of the server (110) making the plurality of human resources compliance forms available to a client (120) and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client. *See, e.g.*, page 15-16, paragraphs [047]-[049]; *see also* Figure 2, act 230. The method (200) further includes an act (250) of the server (110) updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria. *See, e.g.*, page 17, paragraphs [051]-[052]; *see also* Figure 2, act 250. The method (200) also includes an act of the server (110) determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client. *See, e.g.*, page 17, paragraphs [051] and [053]. Finally, the method (200) also includes an act of the server (110) making the updated human resources compliance form available to the client (120) in an order that has been dynamically updated to accommodate the change in the legal criteria. *See, e.g.*, page 15, paragraph [047]; *see also* page 17, paragraphs [051] and [053].

In the example of claim 15, a user interface is provided by a server (110) in a client-server environment (100) for facilitating the management of human resources compliance

efforts. *See, e.g.*, pages 18-20, paragraphs [057]-[064]; *see also* pages 14-20, paragraphs [043]-[064]; *see also* Figures 1-2. The user interface includes first, second, and third interface portions. The first interface portion is configured to provide a client (120) access to a plurality of forms for use in a human resources process. The client (120) access to the forms is controlled at least in part by legal criteria governing the human resources process. At least one of the forms is dynamically updated by the server (110) to reflect changes in the legal criteria. *See, e.g.*, page 17, paragraphs [051]-[052]. An order in which the updated forms are made available by the server (110) to the client (120) has also been dynamically updated to accommodate the changes in the legal criteria. *See, e.g.*, page 17, paragraphs [051] and [053]. The second interface portion is configured to reflect changes in the legal criteria. *See, e.g.*, page 19, paragraph [061]. The third interface portion is configured to reflect status data of employees working for the client. The at least one updated form is also customized for at least one of the employees based on the status of the employee. *See, e.g.*, page 19, paragraph [062].

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- Issue 1: Whether claims 1-10, 29-30, and 32-34 are unpatentable, under 35 U.S.C. §101, as being drawn to patent-ineligible subject matter.
- Issue 2: Whether claims 1-11, 29-30, 32-33 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 7,330,817 to *Exall et al* ("*Exall*") in view of Peace Corps Applicant Toolkit ("*PC*").
- Issue 3: Whether claims 15-18 are unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Number 6,067,522 to Warady et al. ("*Warady*").
- Issue 4: Whether claim 34 is unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks ("*Jinks*").

## VII. ARGUMENT

### A. Issue 1: Whether claims 1-10, 29-30, and 32-34 are unpatentable, under 35 U.S.C. §101, as being drawn to patent-ineligible subject matter.

In the Final Office Action, the Examiner repeated his rejection of claims 1-10, 29-30, and 32-34 under 35 U.S.C. § 101 for purportedly not being drawn to patent-eligible subject matter. Since the July 6, 2009 mailing of the Final Office Action, however, the USPTO issued "Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101" ("*Interim Examination Instructions*").<sup>1</sup> These instructions "supersede previous guidance on subject matter eligibility" and include the following guidance:

An "article" ...can also be electronic data that represents a physical object or substance. For the test, the data should be more than an abstract value. Data can be specifically identified by indicating what the data represents, the particular type or nature of the data, and/or how or from where the data was obtained.

"Transformation" of an article means that the "article" has changed to a different state or thing...A new or different function or use can be evidence that an article has been transformed...transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use.

*Interim Examination Instructions, pages 5-6 (emphasis added).*

#### i. The Examiner erred in asserting that the "human resources compliance form" of claim 1 does not qualify as an "article" under the *Interim Examination Instructions*

Independent claim 1, from which all other claims rejected under 35 U.S.C. § 101 depend, recites an article, namely, electronic data arranged so as to define an electronic "human resources compliance form" that represents a physical object, i.e. a paper "human resources compliance form." As noted in paragraph [043] of the specification:

The term "form" and "human resources form" should be broadly construed to include any employee form, template, manual or other material that can be used to implement a human resources process. Non-limiting examples of forms include

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<sup>1</sup> See Memorandum of Andrew H. Hirshfeld, "Effective Today: New Interim Patent Subject Matter Eligibility Examination Instructions," dated August 24, 2009.

applications [for employment], authorizations, requests, disclosures, instruction materials, and training materials.

Appellants note that a "human resources compliance form" can be either electronic or physical. One example of a physical "human resources compliance form," namely a paper application for employment, is disclosed in paragraphs [050] and [066]. An example of the conversion of a physical "human resources compliance form" to an electronic "human resources compliance form," through scanning a paper form, is disclosed in paragraph [050]. Therefore, although the "human resources compliance forms" recited in claim 1 are electronic "human resources compliance forms," Appellants submit that these electronic "human resources compliance forms" recited in claim 1 represent underlying "physical and tangible objects," namely, physical "human resources compliance forms."

Appellants further note that an electronic "human resources compliance form" represents both the visible data that appears on the physical paper form as well as non-visible data such as paper size of the physical paper form, positioning of visible data on the physical paper form, and size and position of whitespace, such as margins, on the physical paper form.

Thus, the "human resources compliance form" recited in claim 1 clearly qualifies as an "article" under the definition of the term "article" set forth in the *Interim Examination Instructions*.

- ii.      **The Examiner erred in asserting that claim 1 does not recite acts that "particularly transform a particular article to a different state or thing" under the *Interim Examination Instructions***

Claim 1 also recites acts that "particularly transform a particular article to a different state or thing." See *Interim Examination Instructions, page 5*. In particular, claim 1 recites acts that particularly transform at least one "human resources compliance form" to a different state by first "generating" a plurality of "human resources compliance forms" and then "updating" at least one

of the "human resources compliance forms to conform with a change in the legal criteria."

This updating of at least one of the electronic "human resources compliance forms to conform with a change in the legal criteria" clearly qualifies as a particular transformation of a particular article under the *Interim Examination Instructions* because the updated form is suitable for a different use than the originally generated form. In particular, the updating of the originally generated form (to conform with the change in the legal criteria) changes the nature of the article, i.e. the original form, from a form that is no longer legally compliant to a form that is legally compliant. That a transformation has occurred is evidenced by the fact that a legally compliant form is inherently suitable for a different use than a non-legally compliant form. For example, a non-legally compliant form is out-of-date and useless for its intended purpose, while a legally compliant form is current and useful for its intended purpose.

Thus, claim 1 clearly recites acts that "particularly transform a particular article to a different state or thing" under the definition of the term "transformation" set forth in the *Interim Examination Instructions*.

### iii. Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has improperly rejected claim 1, and corresponding dependent claims 2-10, 29, 30, and 32-34, as being patent-ineligible under 35 U.S.C. § 101. Accordingly, the rejections of claims 1-10, 29, 30, and 32-34 under 35 U.S.C. § 101 are not well taken and should be overruled by the Board.

**B. Issue 2: Whether claims 1-11, 29-30, 32-33 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 7,330,817 to Exall et al ("Exall") in view of Peace Corps Applicant Toolkit ("PC").**

Appellants respectfully notes at the outset of VII.B, VII.C, and VII.D that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the

reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See *MPEP § 2141.III*. As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "...[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1396.

i. **Claims 1 and 11**

Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 1 and 11. For example, each of the rejected independent claims 1 and 11 recites "...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client..." (collectively the "*order change elements*").

In the Office Action immediately previous to the Final Office Action, the Examiner conceded that the *order change elements* are not taught by *Exall*, but asserted that the *order change elements* are taught by *PC*. See *Office Action mailed December 19, 2008, page 4*. Appellants responded to this assertion by arguing that *PC* does not teach the *order change elements*. See *Appellants' Paper filed March 19, 2009, pages 15-16*. Then, in the Final Office Action, the Examiner conceded that neither *Exall* nor *PC* discloses the *order change elements*. *Final Office Action, page 5*. However, instead of relying on another reference that purportedly teaches the *order change elements*, the Examiner appears to have opted to simply cite case law and rely on official notice in asserting that the *order change elements* are obvious, alleging as follows:

...it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included determining whether the change in the legal criteria requires a corresponding change in the order in which a form is presented to the client and presenting the forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

*Final Office Action, pages 5-6.* The Examiner's assertions are defective for at least two reasons.

a. **The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application**

First, while the Examiner has relied on *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 as supporting the rejection under 35 U.S.C. § 103(a), the Examiner has failed to demonstrate any similarity between the facts of *KSR* and the facts in the present application. As the examination guidelines make clear "...legal precedent can provide the rationale supporting obviousness only if the facts in the [cited] case are similar to those in the application." *MPEP § 2144 (emphasis added)*. In particular, *KSR* dealt with whether a claim for a "vehicle control pedal apparatus" was obvious because it was a combination of demonstrably known elements (i.e. a support, an adjustable pedal assembly, a pivot, and an electronic control), that were combined according to demonstrably known methods, as demonstrated in specific prior art references.<sup>2</sup>

In contrast, in the present application, the Examiner has attempted to apply this legal precedent to claims for methods for facilitating the management of human resources compliance efforts, as well as claims for computer program products that implement methods for facilitating the management of human resources compliance efforts. The Examiner has not demonstrated how the

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<sup>2</sup> See *KSR* at 1743 ("...we see little difference between the teachings of Asano and Smith and the adjustable electronic pedal disclosed in claim 4 of the Engelgau patent.").

method steps of the claims of the present application constitute the "combination of familiar elements according to known methods." Further, unlike *KSR* where the claim elements were each identified in cited references, the Examiner admittedly has failed to cite any prior art reference that teaches the purportedly "familiar elements." Although the Examiner assumes that the *order change elements* are "*familiar* elements," the Examiner's own concession that the cited references do not teach the *order change elements* is evidence that the *order change elements* are not "*familiar* elements." Therefore, inasmuch as the Examiner has failed to establish that the facts in *KSR* are similar to those in the present application, the rejection lacks an adequate foundation and should accordingly be withdrawn.

**b. The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known**

Second, the Examiner's apparent taking of official notice that the *order change elements* are "*familiar* elements" is improper in this case. As noted in MPEP 2144.03, "While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113." Therefore, it was improper for this official notice to be first taken in the Final Office Action. Further, MPEP 2144.03, directs that "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." (*Emphasis in original*).

Appellants respectfully submit that the *order change elements* are not capable of instant and unquestionable demonstration as being well-known. Instead, the *order change elements* involve specific technology that is capable of determining whether a change in certain legal criteria requires a corresponding change in the order in which an updated human resources

compliance form is presented to a client. Appellants submit that elements with this level of complexity are not properly rejected under 35 U.S.C. § 103(a) based merely on a taking of official notice that these elements are well-known. Therefore, any rejections of claims including the *order change elements* must include a citation to a supporting prior art reference that teaches the order change elements. Finally, the fact that the Examiner has been unable to produce a reference that teaches the *order change elements* strongly suggests that the elements are not "familiar elements."

ii. **Claims 32 and 33**

Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to dependent claims 32 and 33. For example, claims 32 and 33 each depend from claim 1. Therefore, for at least the same reasons set forth at VII.B.i, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 32 and 33. In addition, claims 32 and 33 each include additional elements that are not taught by the cited references.

For example, claim 32 which depends directly from claim 1, recites "generating a notice *regarding the change* in the legal criteria." (*Emphasis added*). Similarly, claim 33, which depends from claim 32, recites "wherein the notice *advises the client of the change* in the legal criteria and instructs the client of the *steps that should be taken to remain compliant with the change* in the legal criteria." (*Emphasis added*). In the rejections of claims 32 and 33, the Examiner simply asserted that *Exall* discloses these elements, and beyond repeating verbatim the language of these claims, cited only "Column 9, lines 21-40" of *Exall* for support for these assertions. *Final Office Action, pages 8-9.*

Appellants note that such a vague reference to “Column 9, lines 21–40” of *Exall*, without more, is not adequate to discharge the duties imposed on the Examiner by 37 CFR 1.104(c)(2), which provides in part that:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(*Emphasis added*). In the present case, the cited passage of *Exall* discloses a variety of different components and processes, and the Examiner has not specifically identified what the Examiner believes to be the correspondence between those components and the elements of claims 32 and 33 emphasized above. In particular, Column 9, lines 21–40 of *Exall* states:

In other such embodiments, the content may be stored remotely as depicted in FIG. 2 where one or more employment law information sources provided content as needed by the environment 280 via a suitable communication channel such as Internet 260. Typically, this information may be provided via one or more server computers 110 associated with the one or more employment law information sources. The environment 280 may in certain instances cache such content in the data store 240, or always work purely as a pass through either by redirecting the user directly to such employment law information servers 110 or by retrieving content from such employment law information servers 110 and in turn passing the content directly to the user. The various types of content discussed above may be available in any suitable format such as HTML, XML, SGML, PDF (Adobe Systems Inc., San Jose, Calif.), VRML, PostScript, Encapsulated Postscript, text, TIFF, GIF, CFM (Cold Fusion), ASP (Active Server Pages), etc. and may include other embedded active components such as HTML forms, JavaScript routines, Java applets, etc.

As can be discerned from a thorough reading of this cited portion of *Exall*, while there is a mention of “employment law information” which is “legal criteria,” there is no mention of any generation of a “notice *regarding [a] change* in the legal criteria” as recited in claim 32. (*Emphasis added*). Further, this cited portion of *Exall* also lacks any mention of a notice that “advises the client of the *change* in the legal criteria” and that “instructs the client of the *steps*

*that should be taken to remain compliant with the change in the legal criteria” as required by claim 33. (Emphasis added).*

Appellants submits that this is the type of situation contemplated by the terms of 37 CFR 1.104(c)(2) that require, among other things, that the Examiner designate “*the particular part* relied on...as nearly as practicable.” In this regard, Appellants note that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” *MPEP § 706.*

As the rule and the examination guidelines clearly indicate then, the duty of the Examiner imposed by the rule and explained in the examination guidelines is owed *to the Appellants*. Particularly, the Examiner must make clear, *to the Appellants*, where and how the references relied upon in the rejection purportedly disclose the claim elements – whether or not the Examiner believes that his explanation is clear is not relevant, *the explanation must be clear to the Appellants*. Unless and until the Examiner has made clear to the Appellants the purported correspondence between the references and the claim elements, the Examiner has failed to fully discharge the duty imposed on the Examiner by the rules. In the present case, the fact that Appellants are unclear as to precisely what the Examiner believes to be the correlation between the references and the claim elements is *prima facie* evidence that the Examiner has not discharged the duty imposed by the rules.

### **iii. Conclusion**

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 11, 32, and 33. Accordingly, the rejections under 35 U.S.C. § 103(a) of claims 1, 11, 32, and 33, and of claims 2-

10, and 29-30 which depend from claim 1, are not well taken and should be overruled by the Board.

C. **Issue 3:** Whether claims 15-18 are unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Number 6,067,522 to Warady et al. ("Warady").

The Examiner has further failed to establish that the cited references, when combined, teach or suggest all the limitations of rejected independent claim 15. For example, rejected independent claim 15 recites "...wherein an order in which the updated forms are made available to the client has been dynamically updated to accommodate the changes in the legal criteria..." (the "*order update element*").

In the Office Action immediately previous to the Final Office Action, the Examiner conceded that the *order update element* is not taught by *Exall*, but asserted that the *order update element* is taught by *PC*. See *Office Action mailed December 19, 2008, page 9*. Appellants responded to this assertion by arguing that *PC* does not teach the *order update element*. See *Appellants' Paper filed March 19, 2009, pages 15-16*. Then, in the Final Office Action, the Examiner conceded that neither *Exall* nor *PC* discloses the *order update element*. *Final Office Action, page 10*. However, instead of relying on another reference that teaches the *order update element*, the Examiner appears to have opted to simply cite case law and rely on official notice in asserting that the *order update element* is obvious, alleging as follows:

...it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included updating the order in which forms are based on changes in legal criteria in the order in which form is presented to the client and presenting the forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any

person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

*Final Office Action, pages 10-11.* The Examiner's assertions are defective for at least two reasons.

i. **The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application**

First, and with reference to the standards set forth above at VII.B.i.a, the Examiner has failed to demonstrate any similarity between the facts of *KSR* and the facts in the present case. The Examiner has attempted to apply *KSR* to claims for user interfaces that implement methods for facilitating the management of human resources compliance efforts. The Examiner has not demonstrated how the user interface portions of the claims of the present application constitute the "combination of familiar elements according to known methods." Further, unlike *KSR* where the claim elements were each identified in cited references, the Examiner has failed to cite any prior art reference that teaches the purportedly "familiar elements." Although the Examiner assumes that the *order update element* is a "familiar element," the Examiner's own concession that the cited references do not teach the *order update element* is evidence that the *order update element* is not a "familiar element." Therefore, inasmuch as the Examiner has failed to establish that the facts in *KSR* are similar to those in the present application, the rejection lacks an adequate foundation and should accordingly be withdrawn.

ii. **The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known**

Second, and with reference to the standards set forth above at VII.B.i.b, the Examiner's apparent taking of official notice that the *order update element* is a "familiar element" is improper in this case. Appellants respectfully submit that the *order update element* is not capable

of instant and unquestionable demonstration as being well-known. Instead, the *order update element* involves specific technology that is capable of dynamically updating an order in which the updated forms are made available to the client to accommodate the changes in the legal criteria. Appellants submit that an element with this level of complexity is not properly rejected under 35 U.S.C. § 103(a) based merely on a taking of official notice that this element is well-known. Therefore, any rejections of a claim including the *order update element* must include a citation to a supporting prior art reference that teaches the *order update element*. Finally, the fact that the Examiner has been unable to produce a reference that teaches the *order update element* strongly suggests that the element is not a "familiar element."

### iii. Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 15. Accordingly, the rejections under 35 U.S.C. § 103(a) of claim 15, and of claims 16-18 which depend therefrom, are not well taken and should be overruled by the Board.

#### D. Issue 4: Whether claim 34 is unpatentable, under 35 U.S.C. §103(a), as being obvious over Exall in view of PC, and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks ("Jinks").

In the interest of brevity, Appellants note that rejection of claim 34, which depends from claim 1, is problematic for at least the same reasons set forth in the discussion of claim 1 at VII.B.i above, and Appellants respectfully direct the attention of the Board to that discussion.

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 34. Accordingly, the rejection of claim 34 under 35 U.S.C. § 103(a) is not well taken and should be overruled by the Board.

## CONCLUSION

Based on the foregoing, Appellants respectfully submit that the rejections of the claims are not well taken. Accordingly, Appellants respectfully request that the Board reverse the Examiner's rejections of claims 1-11, 15-18, 29-30, 32-34 pending in this application and thereby place this application in condition for immediate allowance.

DATED this the 7<sup>th</sup> day of December, 2009.

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

1. **(Previously Presented)** In a client-server environment, a method for facilitating the management of human resources compliance efforts, the method comprising:
  - generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria;
  - making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client;
  - updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria;
  - determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client; and
  - making the updated human resources compliance form available to the client.
2. **(Original)** A method as recited in claim 1, wherein the plurality of human resources compliance forms includes:
  - a first rejection letter form;
  - a second rejection letter form;
  - a conditional acceptance letter form;
  - a drug screening authorization form;
  - background screening authorization form;
  - a third rejection letter form;
  - an intent-not-to-hire letter form; and
  - a new hire document.
3. **(Original)** A method as recited in claim 1, wherein the predetermined legal criteria and human resources compliance forms correspond to employee hiring.

4.       **(Original)**   A method as recited in claim 1, wherein the predetermined legal criteria and human resources compliance forms correspond to employee termination.

5.       **(Original)**   A method as recited in claim 1, wherein the predetermined legal criteria and human resources compliance forms correspond to employee training.

6.       **(Original)**   A method as recited in claim 1, wherein the predetermined legal criteria and human resources compliance forms correspond to employee compensation.

7.       **(Original)**   A method as recited in claim 1, wherein the status data corresponds to at least one of a client characteristic and an employee of the client.

8.       **(Original)**   A method as recited in claim 7 wherein generating the human resources compliance forms includes receiving the status data from the client.

9.       **(Original)**   A method as recited in claim 7, wherein the status data is received from a third party.

10.      **(Original)**   A method as recited in claim 7, wherein the status data is received from a third party resource.

11. **(Previously Presented)** A computer program product for use in a client-server environment, the computer program product comprising one or more computer-readable media having computer-executable instructions for implementing a method for facilitating the management of human resources compliance efforts, the method comprising:

generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria;

making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client;

updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria;

determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client; and

making the updated human resources compliance form available to the client in an order that has been dynamically updated to accommodate the change in the legal criteria.

12. **(Withdrawn)** In a client-server environment, a method for managing human resources compliance, the method comprising:

receiving an employment application from a job applicant;

accepting the employment application if information provided in the employment application meets predetermined criteria, otherwise, rejecting the employment application;

accessing at least one of a plurality of human resource compliance forms that substantially conforms to predetermined legal criteria,

automatically generating, a first rejection letter by populating at least one data field of the first rejection letter form with information extracted from the employment application, if the employment application is rejected;

notifying the job applicant concerning a job interview, if the employment application is accepted;

automatically generating a second rejection letter by populating at least one data field of the second rejection letter form with information extracted from the employment application, if the job interview is unsuccessful;

automatically generating a conditional acceptance letter by populating at least one data field of the conditional acceptance letter form with information extracted from the employment application, if the job interview is successful;

automatically populating at least one field of each of the drug and background screening authorization forms with information extracted from the employment application;

automatically generating a third rejection letter by populating at least one data field of the third rejection letter form with information extracted from the employment application, if the drug screen or background screen is unsuccessful;

automatically generating an intent-not-to-hire letter by populating at least one data field of the intent-not-to-hire letter form with information extracted from the employment application, if the drug screen or background screen is unsuccessful; and

automatically populating at least one field of the new hire document if the drug screen and background screens are successful and the job applicant is hired.

13.       **(Withdrawn)** A method as recited in claim 12, wherein the plurality of human resource compliance forms includes:

- first, second and third rejection letter forms;
- a conditional acceptance letter form;
- drug and background screening authorization forms;
- an intent-not-to-hire letter form; and
- a new hire document.

14.       **(Withdrawn)** A method as recited in claim 12, wherein the application is received in an electronic format.

15. **(Previously Presented)** In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, the user interface comprising:

a first interface portion configured to provide a client access to a plurality of forms for use in a human resources process, wherein client access to the forms is controlled at least in part by legal criteria governing the human resources process, and wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria, and wherein an order in which the updated forms are made available to the client has been dynamically updated to accommodate the changes in the legal criteria;

a second interface portion configured to reflect changes in the legal criteria; and

a third interface portion configured to reflect status data of employees working for the client, the at least one updated form being customized for at least one of the employees based on the status of the at least one employee.

16. **(Original)** A user interface as recited in claim 15, wherein client access includes the ability of the client to modify data used to populate fields on the forms.

17. **(Original)** A user interface as recited in claim 15, wherein the forms are customized according to client characteristics.

18. **(Original)** A user interface as recited in claim 15, further including an interface portion configured to display training materials and to track training progress.

19-22. **(Canceled)**

23. **(Withdrawn)** A method for managing human resources compliance for employee compensation, the method comprising:

identifying different legally permissible compensation plans according to legal criteria governing employee compensation;

for a single employee, calculating different employee compensations based on the different legally permissible compensation plans, the different legally permissible compensation plans including:

at least a first compensation plan based on a salary pay schedule; and

at least a second compensation plan based on an hourly rate pay schedule;

and

selecting one of the compensation plans conforming to the legal criteria and client needs.

24. **(Withdrawn)** A method as recited in claim 23, wherein calculating different employee compensations includes calculating a regular rate of pay accounting for special incentives received by the employee in addition to a base pay.

25. **(Withdrawn)** A method as recited in claim 24, wherein the selection of one of the compensation plans is based at least in part on whether an employee is overtime exempt under the selected plan.

26. **(Withdrawn)** A method as recited in claim 23, wherein calculating different employee compensations further includes performing compensation analysis.

27. **(Withdrawn)** A method as recited in claim 26, wherein the compensation analysis is used to determine a desirable compensation for compensating an employee that is paid on commission.

28. **(Withdrawn)** A method as recited in claim 26, wherein the compensation analysis is used to determine a desirable compensation for compensating an employee that is paid by a flat-rate.

29. **(Previously Presented)** A method as recited in claim 1, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises dynamically updating, in automatic response to a determination that a change in a law has occurred, at least one of the plurality of human resources compliance forms to accommodate the change in the law.

30. **(Previously Presented)** A method as recited in claim 1, wherein updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria comprises:

automatically determining that the change in a law created a conflict with an existing one of the plurality of human resources compliance forms; and

automatically updating the existing human resources compliance form to accommodate the change in the law.

31. **(Canceled)**

32. **(Previously Presented)** A method as recited in claim 1, further comprising:  
generating a notice regarding the change in the legal criteria; and  
making the notice available to the client.

33. **(Previously Presented)** A method as recited in claim 32, wherein the notice advises the client of the change in the legal criteria and instructs the client of the steps that should be taken to remain compliant with the change in the legal criteria.

34. **(Previously Presented)** A method as recited in claim 1, further comprising:  
auto-populating at least one of the human resources compliance forms with data specific to the client; and  
making the at least one auto-populated human resources compliance forms available to the client.

35.     **(Canceled)**

## **IX. EVIDENCE APPENDIX**

None.

**X. RELATED PROCEEDINGS APPENDIX**

None (*see II. above*).